

REMARKS

Applicant thanks the Examiner for the consideration given the present application.

Claims 1-87 are now present in this application. Claims 1, 24, 31, 47, 60, 77 and 85 are independent.

Reconsideration of this application is respectfully requested.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 1-87 stand rejected under 35 U.S.C. § 112, 2nd Paragraph. This rejection is respectfully traversed.

The basis for the rejection is that claims 1-87 fail to differ substantially from each other and for being unduly multiplied. The rejection also refers to MPEP 2173.05(n).

MPEP 2173.05(n) clearly states that undue multiplicity rejections based on 35 USC 112, second paragraph, should be applied judiciously and should be rare. The Office Action has neither alleged, nor presented any objective factual evidence in support of a conclusion, that this Application constitutes the “rare” type of case in which the claims should be deemed to be “multiplicious.”

Moreover, Applicant respectfully notes that this rejection fails to make out a *prima facie* case that claims 1-87 fail to particularly point out and distinctly claim the invention for the following reasons.

In the first place, the text for compliance with the second paragraph of 35 U.S.C. §112, as stated in Miles Lab., Inc. v. Shandon Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), cert. denied, 510 U.S. 1100 (1994) is whether one skilled in the art would understand the bounds of the claims when read in light of the specification. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention, Section 112 demands no more. See, also, In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), which stated that the question under Section 112, second paragraph is whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bonds of the claimed subject matter are distinct. See, also, In re Warmerdam, 33 F3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Moreover, this claims recites "substantially." Use of that term in a claim does not render the claim indefinite if the specification provides a standard whereby one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification, Seattle Box Co., Inc. v. Industrial Coating and packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-4 (Fed. Cir. 1984).

The second paragraph of 35 USC 112 requires claims to be set out and circumscribe a particular area with a reasonable degree of precision and particularity, In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

Applicant respectfully submits that the metes and bounds of claims 1-87 are clear and definite, which is all that is required to satisfy 35 USC §112, second paragraph. In this regard, the Office Action fails to set forth even one example of vagueness or indefiniteness of claims 1-87, or of what claim language is unclear so that one of ordinary skill in the art cannot determine the metes and bounds of the claimed invention.

In the second place, the Application has seven independent claims, each of which differs from the other, and the Office has placed no limit on the number of dependent claims that may be claimed.

In the third place, the Office Action has not presented any reasoning in support of its conclusion that the net result of claims 1-87 is to confuse rather than clarify. No source of the confusion is presented, and Applicant cannot find any. In fact, all 87 claims are written in plain English, which is readily understandable by one of ordinary skill in the art. Moreover, by failing to apprise Applicant of the reasoning in support of this conclusion, Applicant has been denied fundamental substantive and procedural due process to which he is entitled under the Administrative Procedures Act. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

In the fourth place, the Office Action fails to demonstrate that limiting the claims to 20 claims is reasonable or that 20 claims will, on a *prima facie* basis, not be unduly multiplied. In this regard, Applicant respectfully submits that,

when this Application was filed, and currently, the Office does not limit the number of claims that Applicant can file, and Applicant has paid for examination of all pending claims.

Applicant respectfully submits that claims 1-87 particularly point out and distinctly claim the subject matter which Applicant regards as his invention. Applicant also respectfully submits that the claims are not unduly multiplied, per 37 CFR §1.75, and do not confuse a skilled worker concerning the metes and bounds of the claimed invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Applicant also respectfully submits that submission of different claims, in independent and dependent format are proper to protect Applicant's rights from patent infringement and lack of prosecution history estoppel points of view in order to provide the best possible protection to the Applicant.

The Office Action also states that Applicant is required to select no more than 20 claims for purpose of examination.

In order to be completely responsive to this requirement of the Office Action, Applicant selects claims 1-3, 24-26, 31-33, 47-49, 60-62, 77-79 and 85-86, with traverse, for reasons stated above.

Applicant also submits that claims 1-87 should have been examined on their merits in this Office Action because their subject matter is clear and definite, and all 87 claims have already been examined on their merits in

previous Office Actions. Applicant respectfully submits that the Office is engaging in unwarranted piecemeal prosecution.

Cited References

Because neither of the references cited by the Examiner have been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

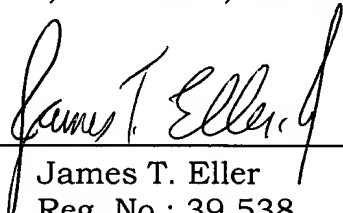
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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